



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/801,932	03/09/2001	Larry L. Lu	06975-127001	3453

26171 7590 10/29/2003

FISH & RICHARDSON P.C.  
1425 K STREET, N.W.  
11TH FLOOR  
WASHINGTON, DC 20005-3500

EXAMINER

ARANI, TAGHI T

ART UNIT	PAPER NUMBER
----------	--------------

2131

DATE MAILED: 10/29/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/801,932

Applicant(s)

LU, LARRY L.

Examiner

Taghi T. Arani

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 21 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13, 16-27 and 30-41 is/are rejected.
- 7) ☒ Claim(s) 14-15, 28-29, 42-43 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

Claims 1-43 were pending for examination.

#### *Claim Rejections - 35 USC § 102*

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-11, 13, 16-25, 27-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Dieterman, U.S. Pat. No. 6,393,464, filed June 1999.

As per claims 1-5, 13, 16-19, 27, 30-33 and 41, Dieterman is directed to a method for controlling the delivery of electronic mail, see abstract.

Dieterman's method utilizes a list of allowed electronic addresses with whom the user is permitted to freely exchange messages, see col. 2, lines 1-40.

According to Dieterman's invention, the sending of email messages by a user and the viewing of email messages received by a user are controlled (i.e. supervised) by an account administrator (i.e. a supervisory recipient) or who establishes and maintains a list of allowed senders and recipients of email messages, see col. 3, lines 34-47.

Dieterman's process of sending an email message begins with the user composing the email message wherein once the user has completed composing an email message it may be saved for later editing or it may be designated as ready to be sent, see col. 4, lines 12-57.

Dieterman further teaches that once designated as ready for sending, the identity of each recipient of the email message prepared by the user is compared to the allowed list (as required by claims 4, 19 and 33) and if all of the recipients are on the allowed list, the email message is placed in the normal mail outbox, where in the next connection

Art Unit: 2131

to the ISP, all messages in the normal outbox are sent onto the internet and the intended recipients.

Dieterman teaches that when performing the comparison between each named recipient and the contents of the allowed list it is determined that not all recipients are in fact in the allowed list, then the email message is placed in (i.e. transmitted to) an alternate outbox designated for messages that require administrator approval before being sent and if an email message is approved by the administrator, the email is moved to the normal outbox for sending upon the next connection to the ISP, see Fig.5. If the email is not approved by the administrator, it remains in the outbox for emails needing approval and will be erased after a predetermined amount of time if no approval is granted. That is, the intended recipient of the email is not notified (as required by **claims 3, 18 and 32**)

Dieterman discloses when a user receives incoming email messages where all email messages addressed to the user are transferred by the ISP to the ISP server and the identity of the sender of each incoming email message is compared to identities appearing on the allowed list (i.e. incoming email messages are being screened), see col. 5, lines 24-46, see also Fig. 5, and moved to an email inbox for approval

In another embodiment discloses that incoming message resides within a single inbox or database list with each message having a status flag set or not set indicating whether each message is approved for viewing by the user or not (i.e. notifying the recipient that the message has been routed to the supervisory recipient (**as required by claims 2, 17 and 31**), col. 5, lines 52- 58, see also Fig. 11.

Dieterman further teaches that screening may be performed by software resident within email terminal, see col. 5, lines 47-51 or in an alternate embodiment, the

Art Unit: 2131

comparison between the sender's address and the allowed list may be performed by the ISP computer instead of the client email terminal, see col. 6, lines 17-28, see also col. 8 claim 8 through col. 10 claims 12.

**As per claims 5-6, 20, and 34**, Dieterman teaches a list of allowed addresses with whom the user is permitted to freely exchange messages, see co. 2, lines 1-19.

**As per claims 7, 21 and 35**, Dieterman teaches each message sent by or sent to the user will be categorized as either authorized if the other party to the communication appears on the allowed list, or unauthorized (i.e. blocked sender) if the other party does not appear on the allowed list and that outgoing messages that are not authorized will not be transmitted (i.e. will be blocked), see col. 2, lines 1-11.

**As per claims 8-11, 22-25, 36-39**, Dieterman teaches that the sending of email messages by a user and viewing of email messages received by a user are controlled by an account administrator (i.e. a supervisory recipient) who establishes and maintains a list of allowed senders and recipients of email messages, see col. 3, lines 34-38, and that the list may reside in a database within is accessible to ISP.

In a primary embodiment Dieterman further teaches that the user is a child having a email account established with the ISP and the account administrator is the child's parent or guardian, recited in claims **9, 23 and 37**. This clearly suggests "establishing the supervisory recipient for the intended recipient" recited in **claims 8, 22 and 36** and that "the intended recipient and the supervisory recipient have related accounts" with "unique screen names", recited in claims **10-11, 24-25, 38-39**.

*Allowable Subject Matter*

**Claims 14-15, 27-28 and 42-43** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Claim Rejections - 35 USC § 102*

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-3,12, 16-18, 26, 30-32, 40** are rejected under 35 U.S.C. 102(b) as being anticipated by Fleming, US Pat. No. 6,128,739, issued October 2000.

In an embodiment, Fleming teaches a method and system whereby an email is routed to a redirected server for delivery to the true owner of the PC. That is, the email is monitored and routed to an intermediary where a location tracking program modifies the e-mail STMP header by substituting the owner address for the recipient address, see col. 4, col. 4, lines 39-67, so that the owner of the PC will receive the e-mail that is sent by the sender. That is, the recipient does not receive the email and the system will alert the sender to the presence of monitoring. In another embodiment, Fleming teaches that the recipient would know that the owner also received the e-mail, see col. 4, line 50-56. In another embodiment, Fleming teaches that neither the sender nor the recipient will receive any indication that the email was redirected, see col. 4, lines 57-65. The fifth embodiment redirects the e-mail to a third part such as a law enforcement, see col. 4, line 66 through col. 5, line 7.

Art Unit: 2131

*Conclusion*

Any inquiry concerning this communication or earlier communications from examiner should be directed to Taghi Arani, whose telephone number is (703) 305-4274. The examiner can normally be reached Monday through Friday from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh, can be reached at (703) 305-9648. The Fax numbers for the organization where this application is assigned are:


After-final (703) 746-7238

Official (703) 746-7239

Non-Official/Draft (703) 746-7240

Taghi Arani

Patent Examiner

  
AYAZ SHEIKH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100